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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,706	12/20/2000	Paul M. Brennan	91436-311	3271

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EXAMINER
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ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 07/29/2004

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/739,706

Applicant(s)

BRENNAN, PAUL M.

Examiner

Md S Elahee

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM  
THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments mailed on 05/17/04 have been fully considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 12, 13, 15 and 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Johnson (U.S. Patent No. 6,741,692).

Regarding claim 1, Johnson teaches maintaining a priority electronic mail repository or log (i.e., log) of past electronic mail items (i.e., incoming communications) for the called party (col.1, lines 66, 67, col.2, lines 1-3).

Johnson further teaches that upon receipt of the electronic mail item (i.e., incoming communication), examining the priority electronic mail repository or log and based on previous log items (i.e., previous incoming e-mail item, col.1, line 67 and col.5, lines 34, 35) from the calling party (i.e., originator), assessing the priority (i.e., urgency) (fig.4-7; col.1, lines 33-36, 66, 67, col.2, lines 1-3, col.4, lines 44-67, col.5, lines 1-11, 21-60).

Regarding claim 2, Johnson teaches incoming communication comprises one of a facsimile transmission, an e-mail, a multi-media communication, an attempted telephone call, and a voice mail message (col.1, lines 66, 67, col.2, lines 1-3, col.4, lines 44-67).

Regarding claim 12 is rejected for the same reasons as discussed above with respect to claim 1. Furthermore, Johnson teaches the server comprising inherently a processor (fig. 1, 2; col.3, line 48-63, col.4, lines 4-13).

Johnson further teaches that computer readable memory inherently in communication with the processor and inherently storing application software adapting the processor, upon receipt of an electronic mail item (i.e., incoming communication) from a calling party (i.e., originator) to a called party (i.e., user) (col.1, lines 66, 67, col.2, lines 1-3, col.4, lines 4-13, 22-28, 44-67).

Regarding claim 13, Johnson teaches that the log stores a time of each of the past communications (col.4, lines 44-67, col.5, lines 1-11).

Regarding claim 15 is rejected for the same reasons as discussed above with respect to claims 1 and 12.

Regarding claim 16, Johnson teaches assessing is further based on log items (i.e., communications) from users (i.e., multiple associated originators) (col.1, lines 66, 67, col.2, lines 1-3, col.3, lines 35-38, col.4, lines 44-67, col.5, lines 1-11).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2645

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Smith et al. (U.S. Patent No. 6,141,412).

Regarding claim 3, Johnson fails to teach "said examining comprises determining an interval since a last communication from said originator". Smith teaches the examining comprises determining a time period of reaching the called party (col.4, lines 4-9; 'time period of reaching the called party' reads on the claim 'interval since a last communication from the originator'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to have examination comprising determining an interval since a last communication from the originator as taught by Smith. The motivation for the modification is to have doing so in order to determine the urgency of the call.

Regarding claim 4, Johnson fails to teach "said examining comprises assessing a duration since any of said originator's communications have been answered or returned". Smith teaches that the examining comprises assessing a time period since any of the contacting parties communications have been answered or returned (col.4, lines 4-9; 'time period' reads on the claim 'duration' and 'contacting parties' reads on the claim 'originator's'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to have examination comprising

Art Unit: 2645

assessing a duration since any of said originator's communications have been answered or returned as taught by Smith. The motivation for the modification is to have doing so in order to determine the urgency of the call.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Javitt (U.S. Patent no. 5,787,162).

Regarding claim 5, Johnson fails to teach "calculating a numerical indicator of urgency including a number of received prior incoming communications from said originator in a time interval prior to receipt of said incoming communication". Javitt teaches calculating a numerical indicator of urgency including a number of received prior incoming communications from the originator in a time interval prior to receipt of the incoming communication (col.4, lines 29-37, col.7, lines 54-60, col.9, lines 36-50). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to calculate a numerical indicator of urgency including a number of received prior incoming communications from the originator in a time interval prior to receipt of the incoming communication as taught by Javitt. The motivation for the modification is to have doing so in order to determine the level of urgency of the communication.

Regarding claim 6, Johnson fails to teach "in response to calculating an indicator having a value above a threshold, identifying said incoming communication as urgent to said recipient". Javitt teaches in response to calculating an indicator having a value exceeding the user's current priority level (i.e., above a threshold), identifying the incoming communication as urgent to the user (i.e., recipient) (col.4, lines 29-37). Thus,

it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to allow a response to calculate an indicator having a value above a threshold, identifying said incoming communication as urgent to said recipient as taught by Javitt. The motivation for the modification is to have doing so in order to determine the level of urgency of the communication.

7. Claims 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Javitt (U.S. Patent no. 5,787,162) and further in view of Arledge et al. (U.S. Patent No. 5,561,703).

Regarding claim 7, Johnson in view of Javitt fails to teach "said incoming communication comprises an electronic mail message and said identifying comprises modifying said electronic mail message to identify it as urgent". Arledge teaches the incoming communication comprising an electronic mail message and the identifying comprising modifying the electronic mail message to identify it as urgent (col.4, lines 7-25, col.6, lines 39-54). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson in view of Javitt to have examination comprising determining an interval since a last communication from the originator as taught by Arledge. The motivation for the modification is to have doing so in order to indicate the urgency of the communication.

Regarding claim 8, Johnson in view of Javitt fails to teach "said identifying comprises notifying a device associated with said recipient of said incoming communication". Arledge teaches the identifying comprising notifying a device associated with the user of the incoming communication (col.4, lines 7-25, col.6, lines

Art Unit: 2645

39-54; 'user' reads on the claim 'recipient'). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson in view of Javitt to have the identifying comprising notifying a device associated with the recipient of the incoming communication as taught by Arledge. The motivation for the modification is to have doing so in order to indicate the urgency of the communication.

8. Claims 9, 10 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Arledge et al. (U.S. Patent No. 5,561,703).

Regarding claim 9, Johnson fails to teach "said maintaining comprises recording a type of each of said past incoming communications". Arledge teaches the maintaining comprising recording a type of each of the past incoming communications (abstract; col.3, lines 63-67, col.4, lines 7-25, col.6, lines 55-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to have the maintaining comprising recording a type of each of the past incoming communications as taught by Arledge. The motivation for the modification is to have doing so in order to indicate the urgency of the communication.

Regarding claims 10 and 18, Johnson teaches that the context (i.e., log) stores a time of each of the past communications (col.3, lines 4-35).

9. Claims 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and Arledge et al. (U.S. Patent No. 5,561,703) and further in view of Miller, Jr. (U.S. Patent No. 6,442,249).



Art Unit: 2645

Regarding claim 11, Johnson in view of Arledge fails to teach “maintaining records of outgoing communications by said user”. Miller teaches maintaining records of outgoing communications by said user (col.7, lines 15-27). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson in view of Arledge to maintain records of outgoing communications by said user as taught by Miller. The motivation for the modification is to have doing so in order to have the urgent reply.

10. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Arledge et al. (U.S. Patent No. 5,561,703).

Regarding claim 14, Johnson fails to teach “stores an indicator of a communications type for each of said past communications”. Arledge teaches storing an indicator of a communications type for each of the past communications (abstract; col.3, lines 63-67, col.4, lines 7-25, col.6, lines 55-65). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to have the maintaining comprising recording a type of each of the past incoming communications as taught by Arledge. The motivation for the modification is to have doing so in order to indicate the urgency of the communication.

11. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Lunn et al. (U.S. Patent No. 6,075,848).

Regarding claim 17, Johnson fails to teach “determining the intervals between at least the last three communications from said originator”. Lunn teaches determining the

Art Unit: 2645

intervals between at least the last three communications from the caller (i.e., originator) (col.5, line 65-col.6, line 14, col.9, lines 35-39). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to determine the intervals between at least the last three calls (i.e., communications) from the originator as taught by Lunn. The motivation for the modification is to have doing so in order to define the call sequence.

12. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and Arledge et al. (U.S. Patent No. 5,561,703) and further in view of Miller, Jr. (U.S. Patent No. 6,442,249) and further in view of Benson et al. (U.S. Pub. No. 2002/0067820).

Regarding claim 19, Johnson in view of Arledge further in view of Miller fails to teach “examining said records of outgoing communications from said user”. Benson teaches examining the records of outgoing communications from the user (page 1, paragraph 0007). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson in view of Arledge further in view of Miller to examine the records of outgoing communications from the user as taught by Benson. The motivation for the modification is to have doing so in order to assess the urgency of the call.

13. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (U.S. Patent No. 6,741,692) and in view of Miller, Jr. (U.S. Patent No. 6,442,249).

Art Unit: 2645

Regarding claim 20 is rejected for the same reasons as discussed above with respect to claim 12. Furthermore, Johnson fails to teach "maintaining records of outgoing communications by said user". Miller teaches maintaining records of outgoing communications by said user (col.7, lines 15-27). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Johnson to maintain records of outgoing communications by said user as taught by Miller. The motivation for the modification is to have doing so in order to have the urgent reply.

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Johnson (U.S. Patent No. 6,735,292) teach Method and system for priority call processing and Heinonen et al. (U.S. Patent No. 6,671,370) teach Method and apparatus enabling a calling telephone handset to choose a ringing indication(s) to be played and/or shown at a receiving telephone handset.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703) 305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703) 305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2645

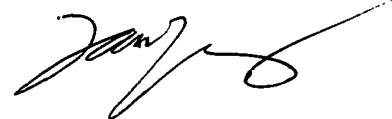
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M.E.

MD SHAFIUL ALAM ELAHEE

July 16, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to read 'Fan Tsang', is written over the printed name and title.